

REMARKS

The Office Action has been carefully considered. In the Office Action, claim 27 was objected to and misnumbered claims 38-50 were renumbered as claims 39-51. Claims 1-26, 28, 30-32, 34-37, 40, 45, 47, and 48 were rejected under 35 U.S.C. § 112, paragraph 2, as being indefinite. Claims 2, 4, 6-10, 13-15, 18, 19, 21-26, and 36 were rejected for being dependent on a rejected claim. Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Luu, U.S. Patent No. 5,860,012 (hereinafter "Luu"). Claims 16, 17, 19, and 22 were rejected under 35 U.S.C. § 102(b) as being anticipated by May et al, U.S. Patent No. 5,809,251 (hereinafter "May"). Claims 2-15, 18, 21, 23-34, 38-39, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May. Claims 42 and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of Herrmann, U.S. Patent No. 5,995,756 (hereinafter "Herrmann"). Claims 35 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May and further in view of Lerche, U.S. Patent No. 6,457,175 (hereinafter "Lerche"). Claims 43-47, 49, and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May and further in view of Herrmann. Claim 48 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May and further in view of Herrmann and Lerche.

By the present amendment, claims 1, 3, 5-8, 16, 17, 27, 28, 33, and 39-51 have been amended and the rejections traversed in view of the following remarks. Reconsideration is respectfully requested.

The Office Action objected to claim 27 for informalities. Claim 27 has been amended to correct the informalities. The Office Action also indicated that in claim 27 the phrase “indicative of installation service” should be changed to “indicative of the installation service.” Applicants note that the phrase “indicative of installation service” is not found in claim 27 as filed. Applicants have found this phrase in claims 33 and 46 and have corrected these claims accordingly.

The Office Action indicated that in the claims as filed there were two claims numbered 38, and therefore renumbered claims 38-50 to be claims 39-51. Applicants have herein likewise renumbered claims 38-50 to be claims 39-51 and have amended the dependent claims in this range to refer to the renumbered claims. Applicants respectfully submit that these informalities have been corrected, and that the objections have been overcome. Reconsideration is respectfully requested.

The Office Action rejected claims 1-26, 28, 30-32, 34-37, 40, 45, 47, and 48 under 35 U.S.C. § 112, second paragraph, alleging that they were indefinite. Claims 2, 4, 6-10, 13-15, 18, 19, 21-26, and 36 were rejected for being dependent on a rejected claim. Applicants have amended claims 1, 3, 5-8, 16, 17, and 28. Applicants respectfully submit that the claims as presented herein are definite under 35 U.S.C. § 112, second paragraph. Applicants further submit that the other claims alleged as being indefinite are definite, as set forth in the following remarks.

The Office Action indicates that the limitation of “client configuration record” in claim 20 is unclear. Specifically, the Office Action states that it is unclear from the scope

of claim 20 “how the configuration request contains a client configuration record before a connection is established with the client machine.” Applicants note that one skilled in the art would recognize that there need not be a connection established to a client machine to have a record about that client machine maintained elsewhere. For example, data found in a client configuration record may be inserted into the record by an administrator or otherwise, without ever having established a connection to the client machine. Moreover, there is no requirement in claim 20 that the configuration request be initiated before *any* communication with the client machine; data found in a client configuration record could be obtained, for example, from a previous communication with the client machine. Applicants respectfully submit that claim 20, as originally submitted, is definite under 35 U.S.C. § 112, second paragraph.

The Office Action also indicates that claim 40 is indefinite because it includes the phrase “period of time.” Applicants disagree that the phrase “period of time” is indefinite, particularly in view of applicants’ specification. One of skill in the art would readily recognize that claim 40 teaches that a second attempt to establish the connection occurs after a delay, which takes *some* period of time, as opposed to re-trying an attempt as soon as possible. The delay might be a second, a minute, an hour, or otherwise. Furthermore, the specification gives some guidance as to some exemplary delays. See, e.g., the application as filed, p. 27. Applicants respectfully submit that claim 40, as filed, is thus quite definite.

The Office Action alleges that claims 11, 12, 30-32, 34, 35, 37, 45, 47, and 48 are indefinite because they do not state “what exactly the configuration request is being queued

or dequeued from.” Applicants note that the above claims are method claims, and respectfully submit that method claims do not require that physical entities (e.g., data structures) be identified for definiteness. Those skilled in the art would readily recognize that queuing or dequeuing a configuration request could be performed using many different data structures, including, for example, a queue, a linked list, an array, or the like. Applicants respectfully submit that 11, 12, 30-32, 34, 35, 37, 45, 47, and 48 as filed are definite.

Turning to the 35 U.S.C. § 102(b) rejections, the present invention is generally directed towards installing management software on client machines without requiring user intervention. This is done at login or through transmitting an installation service to a client, which when executed, installs the management software. Client machines that are candidates for the installation service are discovered by a data discovery manager that runs on a server.

Among other things, the present invention provides a bootstrap-like means by which management software can be installed on a client machine, without requiring one or more systems administrators to manually install the installation service on each computer that in turn is needed to install other software. Once installed, the management software allows the remote maintenance of client computers that includes, for example, deploying applications on the client computers, maintaining and upgrading applications, and removing applications.

Note that the above description is for informational purposes only, and should not be used to interpret the claims, which are discussed below.

In contrast to the present invention, Luu is directed towards installing updates to applications, rather than installing management software and/or an installation service. Significantly, Luu assumes that software capable of installing the updates, i.e., installation software, *has already been installed* on each client machine. Luu is silent as to how this installation software was put on the machine in the first place, let alone provide any teaching or suggestion indicating that the installation software can be automatically installed on each client machine, or how this might be accomplished. Essentially, Luu suffers from the same drawbacks suggested in the background of the present invention, in that Luu requires that an update process, referred to as a terminate and stay resident (TSR) program, already be installed and running on the client machine, before any updates can be processed.

More particularly, in Luu, only an installation package is transmitted to a user workstation. “[T]he installation package includes an IPACK format file and the application software to be installed.” Luu, column 5, lines 16-18. “The IPACK format file defines various groups of commands which are used by the *installation program residing on the user workstation* to install the application software.” Luu, column 5, lines 9-12 (emphasis added). No reasonable interpretation of Luu can find that the installation package that is transmitted is also the already-installed and running installation software that installs that package.

Notwithstanding, the Office Action has apparently confused the already executing (non-transmitted) installer software of Luu with the transmitted package that is to be installed. See e.g., Office Action, p. 4, citing column 2, lines 2-6 to allege that Luu discloses “transmitting an installation service from the server to the client machine.” However, neither the cited text, nor Luu as a whole, discloses or in any way suggests such a concept; Luu’s installation software is not transmitted.

In fact, Luu teaches away from claim 1. Following the teachings of Luu, because the installation program is already executing on the client, there is no need for a system to transmit another copy of the installation program to a client. Doing so even though it was not needed would be worse than pointless, as it would waste bandwidth, disk space, and processing resources.

In sum, Luu does not disclose or suggest transmitting an installation service to the client machine and executing the installation service, let alone disclose or suggest any way in which this might be accomplished, or why it might be desirable. At most, Luu teaches transmitting a set of files and commands for use by an installation program that is explicitly taught as being already installed and executing on a client machine. Further, there is simply no suggestion in Luu that the transmitted installation package to be installed somehow connects to a client access point to obtain the remainder of the management software.

In order to support an anticipation rejection, the Office Action must show that each and every element of the claimed invention is disclosed in a single reference, and that each element is arranged as in the claim. Claim 1 generally recites initiating a connection at a

server to a client machine, transmitting an installation service that installs software from the server to the client machine, and executing the installation service. Thus, claim 1 recites limitations not taught or suggested by Luu. For at least the forgoing reasons, applicants submit that claim 1 and its dependent claims are clearly patentable over Luu. Reconsideration and withdrawal of the §102(b) rejections of claim 1 and its dependent claims based on Luu is respectfully requested.

The Office Action rejected independent claim 16 under 35 U.S.C. § 102(b) as being anticipated by May. In general May suffers the same problems as Luu, and has the same critical deficiencies with respect to the claimed subject matter. Specifically, May does not disclose or suggest transmitting an *installation service* to the client machine. Rather, if anything, an installation program is already executing on the client machine in May, and thus in May, as in Luu, there is no need to transmit an installation program to the client machine, because an installation program is already executing on the client machine. As a result, like Luu, May also teaches away from the claimed subject matter. Furthermore, nowhere does May disclose or suggest that the installation program executing on the client machine installs “at least part of the management software” on the client machine, as further recited in claim 16. This “management software,” even if it exists, would need to be already installed on the client machines of May.

Further, the Office Action alleges that column 13, lines 47-48 of May indicate that a “server must have selected the machine before the connection was made.” However, the cited text of May makes no indication regarding any such device selecting a client, or even

whether any selection occurred at all. The cited text of May simply states that a connection link is established between the management information system and the remote computer (and clients often connect to a server for updates, not the other way around). A reference's silence is not a reasonable basis to support an allegation. Further, applicants note that "selection" indicates that there be more than one client computer from which to choose. There is simply no indication that the management information system of May evaluates information associated with a plurality of discovered machines, and/or selects one of the remote client machines with which to establish a communication, as essentially recited in claim 16. Thus, May also fails to disclose or suggest this teaching of claim 16.

May also does not teach or suggest a data manager that evaluates information associated with discovered machines, and selects one of the remote client machines as a part of a system in which a configuration manager then initiates a connection to the selected machine. In fact, the Office Action concedes that "May does not explicitly teach a data manager." See Office Action, p. 4. Thus, assuming, *arguendo*, that an MIS server of May somehow evaluates information associated with a plurality of discovered machines and somehow selects one of the remote client machines, there is still no showing as to what device in May would somehow correspond to the configuration manager that initiates a connection with the selected client machine. For at least the reasons above, applicants submit that claim 16 and the claims that depend therefrom are clearly patentable over May. Reconsideration and withdrawal of the rejections based on May of claim 16 and the claims dependent on claim 16 are respectfully requested.

Turning to the §103(a) rejections, by law, in order to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997).

The Office Action rejected independent claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May. As discussed above, applicants reiterate that neither Luu nor May disclose or suggest “transmitting an installation service from the server to the client machine, and executing the installation service,” as recited in claim 27. Thus, even if permissible to combine these references, the claim limitations are neither taught nor suggested by the combination, and the Office Action has failed to establish *prima facie* obviousness of the claimed invention. In fact, as also previously noted, both Luu and May teach away from transmitting an installation service. For at least these reasons, claim 27 and its dependent claims are patentable as a matter of law over Luu and/or May, whether the references are considered alone or in any permissible combination. Reconsideration and withdrawal of this rejection is respectfully requested.

The Office Action rejected claim 42 under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of Herrmann. Applicants again point out that Luu does not disclose or

suggest “transmitting an installation service from the server to the client machine, and executing the installation service to install the software” as recited in claim 42. In fact, the very basis on which the rejection is founded is flawed, as the rejection incorrectly presupposes that Luu transmits an installation service, which Luu does not disclose or suggest, (and if anything teaches away from), as discussed above.

Furthermore, there is no disclosure or suggestion in Luu and/or Herrmann of the conditional approach recited in claim 42, wherein if a user has sufficient security, the client machine installs the software, while if the user does not have sufficient security rights, an installation service is transmitted to the client, which executes to install the software. Such a concept is solely taught by applicant, and not found in the prior art. Indeed, the Office Action appears to have selected Herrmann only because it makes a brief reference to security, and then combined Herrmann with Luu in a failed attempt to reach applicants’ claim language. Such a combination can only have been made with impermissible hindsight based upon applicants’ teachings, which is impermissible by law. Indeed, to guard against such impermissible hindsight, in order to support a § 103(a) rejection, by law, there must be some teaching, suggestion, or motivation other than applicants’ teachings for modifying a cited reference or combining references to achieve the claimed invention. The Office Action does not indicate any suggestion or motivation in the prior art of record, either explicit or otherwise, for modifying the references or combining the references in a manner that would achieve the claimed invention, or point out any teaching as to how such a modification or combination might be accomplished, or what might be accomplished

thereby. Instead, the Office Action solely uses applicants' teachings as the basis for the motivation to combine the references to reach applicants' invention, which is contrary to law.

For at least the reasons above, claim 42 is patentable over Luu in view of Herrmann. Reconsideration and withdrawal of the rejections of claim 42 based on Luu and Herrmann, and the claims that depend from claim 42, is respectfully requested.

Claims 35 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May, and further in view of Lerche. Applicants submit that even if these references were somehow permissibly combined, they would still fail to reach applicants claimed subject matter, and in fact would further teach away from transmitting an installation service from the server to the client and executing the installation service.

The Office Action concedes that both Luu and May "do not teach verifying the execution and retrying the execution if the first attempt is unsuccessful," but then contends that Lerche somehow discloses such a concept. However, when compared to the claim language read in its full context, Lerche is silent as to reattempting execution of the installation. In fact, the teaching of retrying execution of an installation comes solely from applicants. Again, it is well settled that the use of applicants' teachings to combine references, as the Office Action has done, is impermissible by law. Reconsideration and withdrawal of the rejections of claims 35 and 37 based on Luu, May, and Lerche are respectfully requested.

Regarding the rejection of claim 48 as being unpatentable over Luu in view of May and further in view of Herrmann and Lerche, applicants submit that even if permissible to combine these (four) references, the present invention is not reached, for at least the reasons set forth above. Moreover, the use of such a prior art mosaic in a Section 103 rejection of claim 48, as well as the other claims, without proper motivation, is impermissible. Proper motivation to combine the references is lacking, especially in view of the references' deficiencies. As has been stated by the Federal Circuit:

“[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” In re Rouffet, 97-1492 (Fed. Cir. 1998).

In the present case, the Office Action did not find every element of the claimed invention, because even if somehow permissibly combined, the references are deficient as discussed above. Moreover, there is no motivation to combine these disparate references,

let alone a showing of how they could be combined to reach the claimed subject matter, or what would be achieved by such a combination. Indeed, the various alleged reasons for combining the references as set forth in the Office Action are unsupported, and to the extent understood, are clearly taken from applicants' teachings, and not from anything in the prior art or elsewhere. In sum, the Office Action has used improper interpretations of the references, as well as impermissible hindsight using applicant's teachings, in a (failed) attempt to reconstruct the claims of the present invention. Such a hindsight reconstruction is clearly impermissible by law. Accordingly, it is respectfully submitted that the Section 103 rejections of the claims are improper for at least these additional reasons, and should be withdrawn. Reconsideration is respectfully requested.

Applicants further note that the Office Action rejected many of the other claims without explanation, other than to state that the rejections were "under the same logic" as other rejections. As such logic was based on a clearly false supposition, (e.g., that the prior software that preformed the installation was transmitted rather than the software that was installed), the rejections of these claims are improper. Moreover, applicants respectfully submit that each claim stands on its own, and should be interpreted based on its own claim language and limitations, and not rejected based on another claim.

In re Application of Young et al.

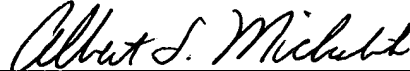
Serial No. 09/599,156

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-51 are patentable over the prior art of record, and that the application is good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



Albert S. Michalik, Reg. No. 37,395
Attorney for Applicants
Law Offices of Albert S. Michalik, PLLC
704 - 228th Avenue NE, Suite 193
Sammamish, WA 98074
(425) 836-3030
(425) 836-8957 (facsimile)

In re Application of Young et al.

Serial No. 09/599,156



CERTIFICATE OF MAILING

I hereby certify that this Amendment, along with Transmittal and Change of Correspondence Address are being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: March 19, 2003


Albert S. Michalik

2230 amendment

RECEIVED
MAR 27 2003
Technology Center 2100